UNITED STATES PATENT AND TRADEMARK OFFICE

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ART UNIT	PAPER NUMBER
2617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/497,071	HOFFBERG-BORGHESANI ET AL.
	Examiner	Art Unit
	Johnny Ma	2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 October 2005</u>.
2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>155-182</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>155-182</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to claims 155-182 have been considered but are moot

in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

3.   Claims 155-181 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. The independent claims 155 ("wherein said data representing

characteristic are not generated by the user"), 162 ("wherein said data representing characteristic

are not generated by the user"), 168 ("based on a correspondence of said selection and

characteristics of available media items generated independently of the user"), 177 ("wherein the

data representing characteristics of media previously selected by the respective user are not

generated by that user"), and 179 ("the at least one parameter not being generated by that

respective user") comprise language "not generated by the user [/that respective user]" or

"generated independently of the user." The scope of these limitations is unclear, whenever a

user selects a media item or a search is performed based on the users previous selections, they

are inherently the result of user action and thus generated by the user, when a user selects or

views media the user actively performs a function to generate characteristics data.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

5.   Claims 155, 162, 177, 179, and 182 are rejected under 35 U.S.C. 102(b) as being

anticipated by Robertson ("New CD-ROM format brings real-time video").

As to claim 155, note the Robertson Article that discloses a system for recommending

books to users based favorite authors. The claimed "storing data describing available media" is

met by the store inventory (available media) for sorting and recommending books to the passer

by wherein it is inherent that the store inventory data be stored for the sorting process (paragraph

12). The claimed "and storing data representing characteristics of media previously selected by a

user" is met by "[t]he customer touches the names of favorite authors (characteristics)…" for the

system to use in performing a search (paragraph 12), note that it is inherent that the favorite

authors (characteristics) be stored at least temporarily in order for the search to be performed.

The claimed "wherein said data representing characteristics are not generated by the user" is met

by the entry of favorite authors by touching the name, as discussed above, wherein favorite

authors are preexisting conditions/characteristics which are not generated by the user (paragraph

12). The claimed "performing a search of said available media for a correspondence to data

representing said characteristics of media previously selected by said user" is met by "the

program, a sort of 'smart clerk,' searches for authors that the customer might also like" in

accordance with the store's inventory (available media) (paragraph 12) wherein the search

represents said characteristics of media previously selected by said user in that a person forms

opinions as to favorite authors from opinions of books (media) by various authors that had been

previously selected. The claimed "notifying said user of available media having characteristics

corresponding to characteristics of previously selected media" is met by the point-of-purchase

system for sorting through a store's inventory and recommend books to the passerby wherein it

is inherent that the system notify the customer of the results of the sorting (paragraph 12) in

order for the system to recommend books to the customer.

As to claim 162, note the Robertson Article that discloses a system for recommending

books to users based favorite authors. The claimed "a controller for controlling delivery of

media to a user" is met by "Apoint-of-purchase system for bookstores uses MS-DOS, a

touchscreen, and CD-ROM technology to sort though a store's inventory and recommend books

to the passerby" (paragraph 12) wherein the point-of-purchase system (controller) controls the

delivery of books (media) to a user through recommendations. The claimed "a processor for

determining a correspondence between data representing characteristics of media within a set of

available media with data representing characteristics of media previously presented to the user"

is met by the point-of-purchase system for which "[t]he customer touches the names of favorite

authors, and the program, a sort of 'smart clerk,' searches for authors that the customer might

also like" (paragraph 12) wherein a processor is inherent to the system for performing a search

for authors that the customer might also like and the correspondence relates to data representing

characteristics of media previously presented to the user in that it is inherent that the books

(media), at least by favorite authors, be previously presented to the user in order for the user to

form an opinion as to favorite authors (characteristics). The claimed "wherein said data

representing characteristics are not generated by the user" is met by the entry of favorite authors

by touching the name, as discussed above, wherein favorite authors are preexisting

conditions/characteristics which are not generated by the user (paragraph 12). The claimed "and

producing a signal dependent on said correspondence" is met by the point-of-purchase system

for recommending authors to a customer wherein it is inherent that a signal dependent on the

correspondence be produced in order to notify the user of recommendations.

As to claim 177, note the Robertson Article that discloses a system for recommending

books to users based favorite authors. The claimed "storing data representing characteristics of

media previously selected by a respective user" is met by "[t]he customer touches the names of

favorite authors, and the program, a sort of 'smart clerk,' searches for authors that the customer

might also like" wherein it is inherent that the favorite authors (characteristics of media

previously selected) be stored, at least temporarily, in the system in order to perform the search

for authors that the customer might also like. The claimed "wherein the data representing

characteristics of media previously selected by the respective user are not generated by that user"

is met by the entry of favorite authors by touching the name, as discussed above, wherein

favorite authors is a preexisting condition/characteristics which is not generated by the user

(paragraph 12). The claimed "determining a set of available media, the set being associated with

data representing characteristics of members of the set of available media" and "determining a

correspondence between data representing a member of the set of available media and data

representing the characteristics of media previously selected by the user" are met by "the

program, a sort of 'smart clerk,' searches for authors that the customer might also like" in

accordance with the store's inventory (available media) (paragraph 12) wherein the search

represents said characteristics of media previously selected by said user in that a person forms

opinions as to favorite authors from opinions of books (media) by various authors that had been

previously selected/read. The claimed "outputting, for the user, an identification of at least one

member of the set of available media having characteristics corresponding to characteristics of

previously selected media by that user" is met by the recommendation of books to the passerby

(paragraph 12) wherein it is inherent that the recommendations be outputted to the user, in order

for the system to recommend books to the passerby.

As to claim 179, note the Robertson Article that discloses a system for recommending

books to users based favorite authors. The claimed "storing data representing at least one

parameter relating prior selections by a respective user" is met by "[t]he customer touches the

names of favorite authors, and the program, a sort of 'smart clerk,' searches for authors that the

customer might also like" wherein it is inherent that the favorite authors (characteristics of media

previously selected) be stored, at least temporarily, in the system in order to perform the search

for authors that the customer might also like. The claimed "the at least one parameter not being

generated by that respective user" is met by the entry of favorite authors by touching the name,

as discussed above, wherein favorite authors is a preexisting condition/characteristics which is

not generated by the user (paragraph 12). The claimed "determining a set of available media,

each member of the set having at least one associated parameter" is met by the store inventory

for searching, wherein it is inherent that the media (books) within the store inventory include at

least one associated parameter in order for a search for recommendations to be performed

(paragraph 12). The claimed "determining a degree of correspondence of prior selections by the

respective user and members of the set of available media based on at least the parameters

relating to prior selections by the respective user and the associated parameters of members of

the set of available media" is met by "the program, a sort of 'smart clerk,' searches for authors

that the customer might also like" in accordance with the store's inventory (available media)

(paragraph 12) wherein the search represents said characteristics of media previously selected by

said user in that a person forms opinions as to favorite authors from opinions of books (media)

by various authors that had been previously selected wherein the available media include

associated parameters as discussed above. The claimed "outputting a reference to at least one

member of the set of available media having an associated parameter based on at least a

correspondence to the at least one parameter relating to prior selections by the respective user" is

met by the recommendation of books to the passerby (paragraph 12) wherein it is inherent that

the recommendations be outputted to the user, in order for the system to recommend books to the

passerby.

As to claim 182, note the Robertson Article that discloses a system for recommending

books to users based favorite authors. The claimed "storing data representing content-related

characteristics of media previously selected by a respective user" is met by "[t]he customer

touches the names of favorite authors, and the program, a sort of 'smart clerk, searches for

authors that the customer might also like" (paragraph 12) wherein it is inherent that the selected

names of favorite authors (content-related characteristics of media previously selected by a

respective user) be stored, at least temporarily, in order for the system to perform a search for

recommendations. Note, that favorite authors are content-related characteristics in that the

author of a novel is related to his/her respective novels content. Furthermore, authors represent

characteristics of media previously selected by a respective user in that it is inherent that the

selection of an author as a favorite represent opinions formed from books written by that author previously selected/read by the user. The claimed "determining a set of available media, the set being associated with data representing content-related characteristics of members of the set of available media" is met by the store's inventory for recommending books and searching for authors that the customer might like (paragraph 12). The claimed "determining a correspondence between content-related characteristics of available media and content-related characteristics of media previously selected by the user" is met by ""[t]he customer touches the names of favorite authors, and the program, a sort of 'smart clerk, searches for authors that the customer might also like" and recommending books to the passerby (paragraph 12). The claimed "outputting, for the user, an identification of at least one member of the set of available media having content-related characteristics corresponding to content-related characteristics of previously selected by that user" is met by the recommendation of books to the passerby wherein it is inherent that the identification of at least one member of the search results be outputted to the user in order for the system to notify and thus recommend books to the user.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 157 and 164-166 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson ("New CD-ROM format brings real-time video") in further view of Hey (US 4,996,462 of record).

As to claim 157, the claimed "wherein said step of notifying said user includes the step of producing a display including a list of the available media meeting a predetermined correspondence criteria on a display screen for viewing by the user." Note the Robertson Article discloses a system for recommending books to a passerby wherein the system searches for authors that the customer might also like (Paragraph 12). The claimed "available media meeting a predetermined correspondence criteria" is met by "[t]he customer touches the names of favorite authors, and the program, a sort of 'smart clerk,' searches for authors that the customer might also like" (Paragraph 12) wherein predetermined correspondence criteria is inherent to the system search for authors that the customer might also like. However, the Robertson Article is silent as to how the recommendations are presented to the customer. Now note the Hey reference that discloses a system and method for recommending items. The claimed "wherein said step of notifying said user includes the step of producing a display including a list of the available media [...] on a display screen for viewing by the user" is met by supplying to display 22 a list of usually the most highly recommended items for that user (Hey 4:18-22). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson Article book recommendation system with the Hey display for notifying the user of recommendations for the purpose of presenting the recommended items to the customer.

As to claim 164, the claimed "wherein said signal produces a list of choices for a user through a human user interface." Note the Robertson Article discloses a system for recommending books to a passerby wherein the system searches for authors that the customer might also like (Paragraph 12). However, the Robertson Article is silent as to how the

recommendations are presented to the customer. Now note the Hey reference that discloses a system and method for recommending items. The claimed "wherein said signal produces a list of choices for a user through a human user interface" is met by supplying to display 22 a list of usually the most highly recommended items for that user (Hey 4:18-22). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson Article book recommendation system with the Hey display for notifying the user of recommendations for the purpose of presenting the recommended items to the customer.

As to claim 165, the claimed "wherein a user interaction with said system serves as an input to an adaptive algorithm of said processor for determining said correspondence." Note the Robertson Article teaches searching a store inventory for recommending books and authors to customers. However, Robertson is silent as to an adaptive algorithm. Now note the Hey reference that discloses users of system 10 enter scalar ratings for items they have sampled such as movies (Hey 3:63-66) and the system uses such data to recommend programs (media) to a user (Hey 3:66-4:28) and the algorithm used for the recommendation is adaptive wherein "[i]t is evident that the greater the number of items that the users have sampled, the more accurate the agreement scalar should be for each of the users with which the selected user is paired" (Hey 6:13-16). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson recommendation system with the Hey adaptive algorithm for the purpose of increasing the accuracy of recommendations to users and thus increase the possibility of making a sale.

As to claim 166, please see the rejection of claim 165 wherein "[a] still further object of this invention is to provide such a system and method which re[q]uire little time or effort on the part of each person in a group to obtain accurate recommendations. Another object of this invention is to provide such a system and method which readily assimilate a new person or item and rapidly accomplishes accurate recommendations for each" (Hey 2:37-44).

8.   Claims 158-159 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson ("New CD-ROM format brings real-time video") in further view of Hey (US 4,996,642 of record) and Bolster ("Reading made fun: BookWhiz").

As to claim 158, the claimed "further comprising a step of altering the produced display by a user using a data entry device." Note the Robertson and Hey combination teaches the produced display. However, the Robertson and Hey combination is silent as to altering the produced display by a user using a data entry device. Now note the Bolster Article that discloses a list of books wherein "[i]f the book seems interesting and the student wishes to find out more about it, the option 'S' will display the remainder of the annotation (up to ten lines), other books by the same author, and books of similar interest" (see page 2). Thus the Bolster Article teaches using a data entry device (keyboard) to alter the produced display by displaying additional information regarding a selected book. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson and Hey combination teaching a produced display with the Bolster altering of the produced display for the purpose of presenting a user with additional information about a selected book, such as a summary, so that a user may quickly determine his/her interest in the selected book.

As to claim 159, please see rejection of claim 158 wherein the user may select a book and request additional information.

9.   Claims 178 and 180-181 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson ("New CD-ROM format brings real-time video") further view of Bolster ("Reading made fun: BookWhiz").

As to claim 178, the claimed "wherein the identification of at least one member of the set of available media having characteristics corresponding to characteristics of previously selected media by that use is presented as a selectable object in a graphic user interface." Note the Robertson Article teaches recommending books to customers. However, the Robertson is silent as a graphical user interface with a selectable object. Now note the Bolster Article that discloses a list of books wherein "[i]f the book seems interesting and the student wishes to find out more about it, the option 'S' will display the remainder of the annotation (up to ten lines), other books by the same author, and books of similar interest" (see page 2). The Bolster Article further discloses a graphical user interface wherein a menu runs throughout the list "Press S, M, B, P, or Q" wherein "S" corresponds to a see more about this book function. Thus the Bolster Article teaches using a data entry device (keyboard) to select a book (selectable object) from a list including a menu (graphical user interface) to obtain additional information. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson book recommending system with the Bolster selectable objects within a graphical user interface for the purpose of presenting a user with additional information about a selected book, such as a summary, so that a user may quickly determine his/her interest in the selected book.

As to claims 180 and 181, the claimed "wherein the reference comprises an object in a graphic user interface" and "wherein the reference comprises a selectable object in a graphic user interface." Note the Robertson Article teaches recommending books to customers. However, the Robertson is silent as a graphical user interface with a selectable object. Now note the Bolster Article that discloses a list of books (objects) wherein "[i]f the book seems interesting and the student wishes to find out more about it, the option 'S' will display the remainder of the annotation (up to ten lines), other books by the same author, and books of similar interest" (see page 2). The Bolster Article further discloses a graphical user interface wherein a menu runs throughout the list "Press S, M, B, P, or Q" wherein "S" corresponds to a see more about this book function. Thus the Bolster Article teaches using a data entry device (keyboard) to select a book (selectable object) from a list including a menu (graphical user interface) to obtain additional information. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Robertson book recommending system with the Bolster selectable objects within a graphical user interface for the purpose of presenting a user with additional information about a selected book, such as a summary, so that a user may quickly determine his/her interest in the selected book.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (571) 272-7351. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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